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09/200,509 11/25/98 YELLOP

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EXAMINER

TM02/0925

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BARTUSKA, F
ART UNIT

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 18

Application Number: 09/200,509
Filing Date: November 25, 1998
Appellant(s): Yellop et al

MAILED

SEP 24 2001

Technology Center 2600

Stephan J. Filipek
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed August 20, 2001.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

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A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 1-5, 7, and 9-11 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

The rejection of claims 12 and 13 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

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The rejection of claims 14-19 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *Claims Appealed*

A substantially correct copy of appealed claims 1-19 appears on pages 1-5 of the Appendix to the appellant's brief. The minor errors are as follows: Claims 1 and 2 do not include the changes made by the Amendment filed Aug. 3, 2001, paper number 15. Claims 1 and 2 should appear as follows:

1. A method of validating articles of currency, comprising:

checking, prior to determining whether or not the article is to be accepted or rejected, the measured properties of an article against a plurality of sets of criteria, each set corresponding to a predetermined type of article;

determining whether the article is a valid type of one of the predetermined types and issuing a signal indicative of whether the article is to be accepted or rejected; and

subsequently determining whether the measured properties meet at least one further set of criteria of an article of a different type.

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2. A method as claimed in claim 1, wherein the combination of sets which are checked prior to issuing the signal is altered.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

4,936,435	GRINER	6-1990
5,355,989	BEST	10-1994

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-5, 7 and 9-19 are rejected under 35 U.S.C. 102(b) or 103(a). This rejection is set forth in prior Office action, Paper No. 10.

(11) *Response to Argument*

The appellants argue that Griner does not teach or suggest "subsequently determining whether the measured properties meet at least one further set of criteria of an article of a different type." as in appellants' claim 1. It is the examiner's position that Griner teaches a method for validating three types of articles, namely nickels, dimes and quarters. The coins are checked against different sets of criteria corresponding to nickels, dimes and quarters. As shown in Fig. 4 of Griner before a dime is accepted or rejected it is checked against the sets of criteria corresponding to nickels and quarters and after not being accepted as either a nickel or a quarter, the dime is checked against the different set of criteria that corresponds to dimes.

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The method of checking a dime in the device of Griner clearly meets all the limitations of appellants' claims 1, 9 and 11; that is, being checked against a plurality of sets of criteria, corresponding to a nickel and a quarter, and determining that the dime is neither a valid nickel nor a valid quarter and subsequently determining if the dime meets the set of criteria for a dime.

Re claim 9 the appellants argue that Griner does not anticipate the limitation that the further set of criteria represents an article that is to be rejected. It is the examiner's position that this is only a statement of intended use. If for some reason the operator of the machine of Griner does not want to accept dimes, they can be returned with the rejected coins. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Re claim 11 the appellants argue that Griner does not disclose storing the number of articles which have met the further set of criteria. It is the examiner's position that this storing the number of acceptable articles is nothing more than the normal value accumulator that is used in all coin operated machine. The value of the coins is stored so that the appropriate

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charge can be made and the appropriate change can be returned. “[I]n considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom.” *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

Re claims 14-19 the appellants argue that Best does not teach or suggest checking the measured properties against a plurality of different sets of criteria, wherein each set corresponds to a different type of article. It is the examiner’s position that Best discloses accepting a plurality of denominations in col. 1, lines 27-36 and having an acceptance band for each denomination. Each acceptance band comprises a set of criteria for a particular denomination and each coin would be checked against each set of criteria. Further, the appellants argue that Best does not teach or suggest altering the set of denominations to be checked. It is the examiner’s position that the claims do not include the limitation that the set of denominations is altered. Rather, the claims state that the criteria for acceptance is altered or rendered ineffective. The switching from one range K to the other range K’ in Best is altering the set of criteria that defines an acceptable coin of a particular denomination. The particular denomination is still accepted but a different set of criteria is used to determine if the coin is of that denomination.

Re claim 18 the appellants argue that Best does not check a number of sets of criteria substantially equal to the maximum number possible during the validation period. It is the

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examiner's position that Best does not place any limits on the number of denominations that can checked so it is, of course, capable of checking for a number substantially equal to the maximum number possible. Is it not axiomatic that any machine or process is capable of operation at its maximum limits?

Re claim 19 the appellants argue that Best does not accept only coins belonging to the same currency. It is the examiner's position that it is well known to use only one currency in a coin accepting machine. Very few coin accepting machines have means to accept plural currencies which would require means to account for the ever changing currency exchange rates. "[I]n considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom." *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

Re claims 2-5, 7, 10, 12 and 13 the appellants argue that there is no motivation to combine Griner and Best. It is the examiner's position that the teaching in Best of altering the acceptance band to try to limit the number of counterfeit coins accepted without overly limiting the number of good coins rejected is ample motivation to use such teaching in other coin accepting devices. All coin acceptors are concerned with limiting the number of counterfeit coins accepted.

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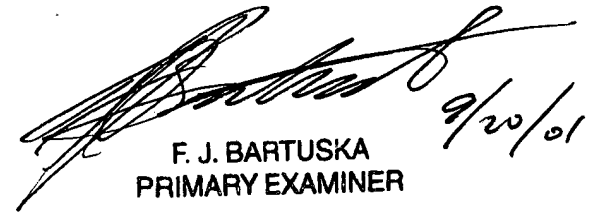
Re claim 12 the appellants argue that Best does not teach or suggest altering the sequence. It is the examiner's position that altering any part of a sequence is altering the sequence. Therefore, altering one of the acceptance bands from K to K' in the sequence of checking the coins in Best is altering the sequence.

Re claim 2 the appellants argue that the amendments after final rejection remove any possible ambiguity in the sentence structure. It is the examiner's position that Best in col. 5, lines 42-55 clearly discloses that the sets of criteria are altered before an accept signal is issued just as stated in claim 2.

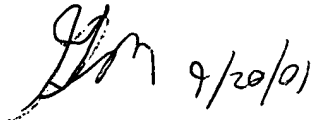
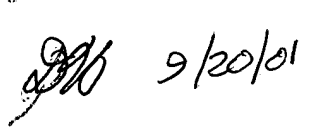
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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


F. J. BARTUSKA
PRIMARY EXAMINER

fjb
September 20, 2001

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